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EXAMINER

CHUNG, JASON J

ART UNIT PAPER NUMBER

2611

DATE MAILED: 05/09/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

B

Office Action Summary

Application No.

09/476,291

Applicant(s)

RANTA, CRAIG S.

Examiner

Jason J. Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 2/19/03 have been fully considered but they are not persuasive. The applicant arguments about improper hindsight with respect to the independent claim are considered, but the examiner respectfully disagrees with the assertions; the applicant's arguments with respect to claims 9, 10, 18, and 19 are not in the claimed subject matter and the examiner respectfully disagrees with the assertions.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The examiner is not using the motivation of the applicant to combine the references. As stated by the examiner, the motivation to combine is, "to put data in the horizontal overscan

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instead of the VBI as taught by Small so the coupon data does not interfere with closed captioning data.” The examiner is not using the applicant’s disclosure directed to placing the data in horizontal overscan. The examiner is relying on the specific disclosure of Small as to why it would be advantageous to put data in the horizontal overscan instead of the VBI.

At column 5, lines 23-25, Small specifically discloses that placing the auxiliary data (in this case audio signals) in the horizontal overscan period would result in a transmission that “does not interfere or corrupt portions of the vertical or horizontal intervals” (see column 5, lines 29-31 specifically). Therefore, there is an explicit teaching in Small to use the overscan period to avoid interference with **both** the horizontal and vertical blanking periods. Small further discloses the specifics of encoding the signals in the overscan period at column 5, line 65-column 6, line 25, the examiner counters applicant’s argument that there is no specific reason to avoid interference in the VBI by using the overscan period by pointing out to the express teaching in Small.

Regarding the applicant’s arguments on claims 9-10 rejections, state that the user cannot scroll through a list of data stored. This is not in the claim language. Claim 9 states the, “mode key selects a storage **or** a redeem mode”, which means only one of the limitations must be met. As disclosed in the first Office Action by the examiner citing Mankovitz, Mankovitz discloses information is protected and may then be used for redeeming the coupon and alternatively for canceling the coupon (column 6, lines 1-5). The applicant’s arguments with respect to the setup mode are not in the claimed subject matter of claim 10 and therefore the limitations are still met by the rejections.

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Regarding claims 17-18, the claims do not recite a "plurality of coupon types". The examiner takes a broader interpretation of the claim.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., switching between modes, scrolling through a list of data stored) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Small.

Regarding claim 1, Mankovitz discloses a system for storing transmitted data (coupon) during the VBI of a television (video) signal. Mankovitz discloses that the stored data is equivalent to a discount (coupon) (column 3, lines 5-11). Mankovitz discloses a decoder for extracting coupon data from the vertical blanking interval (column 4, lines 21-25). Mankovitz discloses the portable data coupon 12 is also called an electronic coupon (column 3, lines 44-49). Mankovitz discloses a data coupon (electronic coupon) (column 4, lines 12-13). Mankovitz

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discloses the user being prompted to transfer received data from the temporary storage RAM 36 to a protected storage if the user desires to do so (figure 2, column 5, lines 1-4). The data (coupon data) is stored on ROM 46 (protected storage), accessible by the microprocessor for transmission with the data (coupon data) to the receiving apparatus that includes a data transmission system that employs a dialogue approach with the microprocessor of the portable data coupon for review of data contained, extraction of data, and confirmation of the identification (column 5, lines 14-25). Mankovitz discloses the encoded data which is stripped and placed in temporary memory; the coupon user may retrieve the information by pressing a read key; the information is then displayed to the user (column 5, lines 29-46), which inherently has a controller within the coupon to retrieve the information for display since the retrieving has to be done by a controller. Mankovitz discloses after completion of the television commercial the user is prompted that a coupon was provided with the commercial, and the user has the option to store the coupon in protected storage (non-volatile memory) to be later redeemed (displayed) by the user (column 5, lines 57-67 and column 6, lines 1-3), which meets the limitations on after the transmission session ends.

Mankovitz fails to disclose the coupon data extracted **from the** horizontal overscan portion of the video signal during a transmission session. Small discloses encoding audio signals into the portion between the horizontal blanking portion and the visible image (column 5, lines 25-28), which means the audio data is placed in the horizontal overscan. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz to put data in the horizontal overscan instead of the VBI as taught by Small so the coupon data does not interfere with closed captioning data.

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Regarding claim 2, Mankovitz discloses the user will depress the read key and the microprocessor retrieves the encoded data (coupon) from a memory location in the RAM and decode the data (coupon data) for output to the display (column 4, lines 21-25), which meets the limitations on a decoder integrated in the electronic coupon since the area cited by the examiner refers to figure 2 and figure 2 is a portable data coupon (column 4, lines 12-13).

Regarding claim 3, Mankovitz discloses a LCD for displaying decoded data (coupon data) (column 4, lines 21-27) in relation to the description of figure 2.

Regarding claims 4-5, Mankovitz discloses a UPC bar code that can be redeemed using a laser scanner (column 5, lines 47-56); the laser scanner meets the limitations on bar code scanner.

Regarding claims 6-7, Mankovitz discloses a television commercial presenting a coupon after the commercial is completed (column 5, lines 57-64).

Regarding claim 8, the limitations on a transmission session comprising of a playback of video taped program (column 6, lines 19-26, Mankovitz), which is used in a VCR. Since the video taped program is used in a VCR, the video taped program meets the limitation on magnetic media.

Regarding claim 9, Mankovitz discloses if the save key is pressed; the information is protected (saved) and may be redeemed (column 6, lines 1-3).

Regarding claim 10, Mankovitz discloses the data coupon includes a card ID number in the keystroke sequence of a remote control allowing (select a set-up mode) the data to be saved in separate portable data (coupon data) coupons (electronic coupon) (column 7, lines 55-60).

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Regarding claim 11, disclosed in claim 8 rejections is a video taped program, which comprises of videotape; videotape is a form of magnetic media.

Regarding claim 12, the ROM disclosed in claim 1 inherently comprises an electrical circuit in order to interact with the microprocessor.

Regarding claim 13, Mankovitz discloses receiving and storing data (coupons; as disclosed in claim 1 rejections) provided by the transmission during the VBI of a television (video) broadcast signal and Small discloses inserting audio data into the horizontal overscan as disclosed in claim 1 rejections. The motivation for combining Mankovitz and Small is the same motivation as in claim 1 rejections and therefore the combination meets the limitations on line 4 of the applicant's claim and the limitations in the preamble. The limitations in lines 5-6 of the applicant's claim have been covered in claim 1 rejections. The limitations in lines 7-8 have been covered in claim 1 rejections. The limitations covered in claim 13 are considered to be part of the claim rejections for all of claim 13's dependent claims (claims 14-23). Some of the dependent claims state that they have been previously covered, the limitations have, however their dependencies have changed and are viewed by the examiner to depend on claim 13 and any further dependent claims.

Regarding claim 14, the limitations in claim 14 have been covered in claim 6 rejections.

Regarding claim 15, the limitations in claim 15 have been covered in claim 8 rejections.

Regarding claim 16, the limitations in claim 16 have been covered in claim 1 rejections.

Regarding claim 17, since the coupon is stored in a non-volatile memory as disclosed in claim 1 rejections, the coupon is retrieved from the memory, which meets the limitations in claim 17.

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Regarding claim 18, Mankovitz discloses the user being prompted for transferring the desired (selected) stored coupon data from temporary storage to protected storage and displays a flashing character on the display (set up menu) (column 5, lines 1-7), which meets the limitations on displaying a set-up menu.

Regarding claim 19, the limitations in claim 19 have been covered in claim 18 since claim 18 uses a remote control, which at some point in time is controlled by a user and the user determines that the coupon data is of the coupon type that they want.

Regarding claim 20, the limitations in claim 20 have been covered in claim 4 rejections.

Regarding claim 21, the limitations in claim 21 have been covered in claim 5 rejections.

Regarding claim 22, the limitations in claim 22 have been covered in claim 11 rejections.

Regarding claim 23, the limitations in claim 23 have been covered in claim 12 rejections.

Regarding claim 24, as disclosed in claim 1 rejection, Mankovitz discloses coupon information is in the VBI. Small discloses the limitation for horizontal overscan in claim 1 rejection. Mankovitz discloses a microprocessor retrieves the data from memory and uses a decoder for extracting coupon data from the vertical blanking interval (column 4, lines 21-25), which meets the limitation on decoder and processor. The limitation for memory has been met in claim 1 rejection. The limitation for means to enable has been met by the controller in claim 1 rejection.

Regarding claim 25, the limitations in claim 25 have been met in claim 11 rejection.

Regarding claim 26, the limitations in claim 24 have been met in claim 1 rejection. Mankovitz discloses the additional limitation of the processor being logically coupled to the display (column 4, lines 21-27). Mankovitz discloses the read key 28 and the save key 24 (read

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and save = at least one control key) on the coupon (figure 1a and column 3, lines 63-67 and column 4, lines 1-7), which meets the limitation on enabling a user to select a storage mode and enabling a user to select a redeem mode.

Regarding claim 28, the limitations in claim 28 have been met in claim 1 rejection.

Regarding claim 30, the limitations in claim 30 have been met in claim 26 rejection.

Claims 27 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Small in further view of Holman.

Regarding claim 27, the limitations in claim 27 have been met in claim 24 rejection. Mankovitz discloses the coupon information is sent to the user and the user may review (evaluate) the information and determine if it should be saved (matches the one selected coupon) and if the information is of no interest pressing the cancel (not storing) key (column 5, lines 57-67 and column 6, lines 1-5).

Neither Mankovitz nor Small discloses selecting at least one coupon from a plurality of coupons. Holman discloses pressing a display list (set up mode) button (control key) selecting from a plurality of coupons (column 6, lines 39-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz in view of Small to select at least one coupon from a plurality of coupons as taught by Holman in order to give the user a list of coupons the viewer wishes to redeem.

Regarding claim 29, the limitations in claim 29 have been met in claim 28 rejection. Mankovitz discloses the coupon information is sent to the user and the user may review (evaluate) the information and determine if it should be saved (matches the one selected coupon)

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and if the information is of no interest pressing the cancel (not storing) key (column 5, lines 57-67 and column 6, lines 1-5).

Neither Mankovitz nor Small discloses selecting at least one coupon from a plurality of coupons. Holman discloses selecting from a plurality of coupons (column 6, lines 39-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz in view of Small to select at least one coupon from a plurality of coupons as taught by Holman in order to give the user a list of coupons the viewer wishes to redeem.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (703) 305-7362. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

JJC
May 5, 2003



ANDREW FAILE
SUPERVISORY PATENT EXAMINER
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